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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/573,052 | 03/22/2006 | Giovanni Meazza | 163-689 | 8978 |
| 7590 James V Costigan Hedman & Costigan 1185 Avenue of the Americas New York, NY 10036-2601 | | | EXAMINER HAYLIN, ROBERT H | |
| | | | ART UNIT 1626 | PAPER NUMBER |
| | | | MAIL DATE 01/20/2010 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/573,052

Applicant(s)

MEAZZA ET AL.

Examiner

ROBERT HAVLIN

Art Unit

1626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 13 and 17 is/are rejected.
- 7) ☒ Claim(s) 14-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

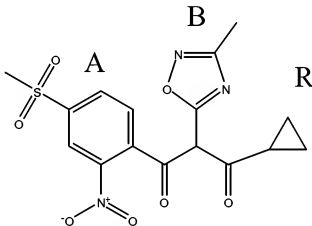
DETAILED ACTION

Status of the claims: Claims 2, 13-17 are currently pending.

Priority: This application is a 371 of PCT/EP04/10653 (09/21/2004) and claims foreign priority to ITALY MI2003A 001855 (09/29/2003).

Election/Restrictions

1. Applicant previously elected Group I (product of Formula I) and the species of compound No. 22 (Table 1 on page 163):



1-cyclopropyl-2-(3-methyl-1,2,4-oxadiazol-5-yl)-3-(4-(methylsulfonyl)-2-nitrophenyl)propane-1,3-dione

As detailed in the following rejections, the generic claim encompassing the elected species was not found patentable. Therefore, the provisional election of species is given effect, the examination is restricted to the elected species only, and claims not reading on the elected species are held withdrawn.

Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection through amendment, the amended Markush-type claim will be

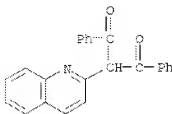
reexamined to the extent necessary to determine patentability of the Markush-type claim. See MPEP § 803.02.

RESPONSE TO APPLICANT'S REMARKS / AMENDMENTS

Claim Rejections - 35 USC § 102

2. Claims 2, 13, and 17 were rejected under 35 U.S.C. 102(b) as being anticipated by Chichibabin (CAPLUS Abstract (Accession # 1928:615) of: Chichibabin, A. E., *Berichte der Deutschen Chemischen Gesellschaft [Abteilung] B: Abhandlungen* (1927), 60B, 1607-17.).

Chichibabin teaches the following compound:



Which anticipated the claim when "A" is phenyl (an aryl group), "B" is 2-quinolinyl ("D" can be heteroaryl), and "R" is phenyl (an aryl group) as described by formula I.

Applicant deleted the alternative of aryl or arylalkyl groups from the scope of "R" thereby avoiding the prior art. This rejection is **withdrawn**.

Claim Objections

3. Claim 2 was objected to because of the following informalities: it does not end with a period. Applicant added the period, thereby avoiding this objection.

NEW CLAIM REJECTIONS

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 2, 13, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by McElvain et al. (CAPLUS Abstract (Accession # 1941:42347) of: Journal of the American Chemical Society (1941), 63, 2192-7).

The prior art teaches the following compound:



Which anticipates the claim when "A" is furyl, "B" is furyl, and "R" is hydrogen as described by formula I.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2, 13, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following part of the claim has conflicting definitions because it is not clear how "D" can be "monocyclic" and "polycyclic" at the same time:

D represents: a monocyclic heterocyclic group of the heteroaryl or-heterocyclic type,
~~in all the above cases the heterocycle~~ which can be mono or polycyclic and can be

One of ordinary skill in the art would not know whether the claim scope includes polycyclic heterocyclic groups or not. Appropriate correction is required.

Claim Objections

8. Claims 14-16 are objected to for being dependent on a rejected base claim.

Conclusion

The claims are not in condition for allowance. Applicant's amendment necessitated any new grounds of rejection and **THIS ACTION IS MADE FINAL**.

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT HAVLIN whose telephone number is (571)272-9066. The examiner can normally be reached on Mon. - Fri., 7:30am-5pm EST.

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If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Joe McKane can be reached at (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert Havlin/
Examiner, Art Unit 1626

/Rebecca L Anderson/
Primary Examiner, Art Unit 1626